

REMARKS

Claims 1 – 25 remain in the application. Claims 1 – 21 and 23 – 25 stand rejected. Claims 7, 19 and 20 are amended herein. Claim 18 is canceled and rewritten herein as new claim 26. No new matter is added. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claim 22 is not rejected in the detailed action and so, is deemed objected to for depending from a rejected base claim, but would be allowable if rewritten in independent form.

Dependent claim 7 is rejected under 35 U.S.C. §112 as being indefinite for failing to “set forth the metes and bounds of the patent protection desired.” In particular, the Office action asserts that dependent “claim 7 recites the broad limitation, ‘a plurality of cells’, and the claim also recites, ‘at least one cell is,’ which is the narrower statement of the range/limitation.” (Emphasis from the Office action.) Claim 7 recited a “wireless communications network as in claim 1, wherein said at least one cell is a plurality of cells,” Claim 1 recites “at least one base transceiver station (BTS), each BTS communicating wirelessly with ones of said MS units in a network cell;” and, therefore, “at least one cell” is inherent in “at least one BTS,” just as “a plurality of BTSs” is inherent in “a plurality of cells.” Further, “a plurality of cells” includes “at least one cell,” but not vice versa; therefore, “a plurality of cells” properly narrows “at least one cell.” Claim 7 is amended herein, however, for clarity to explicitly, rather than implicitly, recite “wherein said at least one BTS is a plurality of BTSs... .” Reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §112 is respectfully requested.

Claims 3, 4, 6, 12 – 14, and 18 – 21 are rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office action indicates nothing specific with respect to the rejected claims. Instead, in a matter more appropriately addressed with an objection to the specification, the Office action asserts that “the Applicant vaguely discloses in

the Specification on page 5 lines 5 – 9 where a fake call control connection is originated in parallel to the said MT-LR request, no representation is indicated in the referenced figures; thus, hampering **one of ordinary skill in the art** to clearly interpret the Applicant's claimed language." Office action, page 2, second paragraph (emphasis added). The proper test for enablement is "whether (the) disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to **enable one skilled in the pertinent art** to make and use the claimed invention." MPEP §2164.01 (emphasis added). The applicant's assert that the present application is sufficient to enable a skilled artisan to make and use the invention without undue experimentation. The applicants are unaware of anything in 35 U.S.C., 37 C.F.R., or anywhere else that would provide a basis for rejecting claims because the specification "hamper[s] **one of ordinary skill in the art** to clearly interpret the Applicant's claimed language." *Supra*, (emphasis added). Other than this apparent objection to the specification, the Office action includes no specific indication of anything being wrong with, nor any guidance as to how to the claims might be amended, to remedy this rejection of claims 3, 4, 6, 12 – 14, and 18 – 21.

37 C.F.R. §1.75(d)(1) provides in pertinent part that the "**claim or claims must conform** to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." The claims are clearly supported by the figures and written description, and so, conform with the requirements of 37 C.F.R. §1.75(d)(1). "It should be noted; however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112." MPEP §1302.01. Furthermore, while limiting oneself to the thumbnail description of "fake call control connection" provided on page 5, lines 5 – 9, may not provide much information; if one were to venture beyond page 5, line 10, to the description of Figures 2A – B in the succeeding 3 pages, one (provided one were a skilled artisan) would very well know how to make and use the invention as recited, and not just in claims 3, 4, 6, 12 – 14, and 18 – 21, but in all of claims 1 – 25.

As the rejection of claims 3 – 4, 6, 12 – 14, 26 (18) and 19 – 21 is non-substantive, and further, no substantive rejection has been made of dependent claims 3 – 4, 6, 12 – 14, 26 (18) and 19 – 21, dependent claims 3 – 4, 6, 12 – 14, and 18 – 21 are otherwise deemed objected to for depending from a rejected base claim, but would be allowable if rewritten in independent form. Claim 18 has been rewritten in independent form as claim 26, and so, claims 26 and 19 are allowable. Further, because no legal authority has been cited as a basis that would support rejecting these claims (i.e., because the specification “hamper(s) one of ordinary skill in the art to clearly interpret the Applicants claimed language”), the rejection of claims 3 – 4, 6, 12 – 14, 26 (18) and 19 – 21 is improper. Reconsideration and withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

Claims 1, 2, 5, 7 – 10 and 15 are rejected as being unpatentable under 35 U.S.C. §102(e) over published U.S. Patent Application No. 2005/0043041 A1 to Ignatius et al. Claims 16, 17 and 23 – 25 are rejected as being unpatentable under 35 U.S.C. §102(b) over *Digital Cellular Telecommunications Systems (GSM)*; *Universal Mobile Telecommunications System (UMTS)*; *Functional Stage 2 Description of Location Services (3GPP)*. Claim 11 is rejected under 35 U.S.C. §103(a) Ignatius et al. in view of 3GPP. Claims 3, 4, 6, 12 – 14, and 18 – 21 have not been substantively rejected and so, are deemed patentable. The rejection of claims 1, 2, 5, 7 – 11, 15 – 17 and 23 – 25 is respectfully traversed.

It is asserted that Ignatius et al. teaches the present invention, with specific reference to paragraphs 0007, 0040, 0041, 0042, 0044, 0047, 0052 and 0061, as recited in claims 1, 2, 5, 7 – 10 and 15. The rejection is respectfully traversed.

Regarding the rejection of claim 2 it is asserted that Ignatius et al.

disclose(s) wherein a response to said request for services is provided to one MS unit **before** a response is provided for said LCS request. Ignatius et al. inherently provides support of the above language; in that, **prior to the user initiating a request**, a response regarding the presence of the said user in the area of the receiving base station is **received by the said user equipment (MS)**. See paragraphs {0042 and 0044}.

(emphasis added.) However, this very clearly shows that Ignatius et al. does not teach the present invention as recited in any of claims 1 – 25.

“According to a preferred embodiment of the present invention, MO transactions are allowed to originate and complete even in the presence of an ongoing MT-LR.” Application, page 4, lines 31-32. In other words, “requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes.” Claim 1, lines 9, 10. More specifically, as claim 2 requires, “a response to said request for services is provided to said one MS unit before a response is provided for said LCS request.” Thus, as is described in detail in the present application at page 5, line 10 – page 7, line 28, the user may make requests (e.g., emergency calls) uninhibited by whether “a response regarding the presence of the said user in the area of the receiving base station is **received by the said user equipment (MS)**.” Ignatius et al., *supra* (emphasis added). More particularly, the present invention specifically allows the user to initiate a request (e.g., a 911 call) during a location services communication; while Ignatius et al. is restricted to “**prior to the user initiating a request**, a response regarding the presence of the said user in the area of the receiving base station is **received by the said user equipment (MS)**.” *Id.* (emphasis added) Therefore, Ignatius et al. could not teach the present invention as recited in claims 1, 2 and 10. The applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2 and 10 under 35 U.S.C. §102(e) over Ignatius et al.

Furthermore, because dependent claims include any differences with the prior art as the claims from which they depend, dependent claims 5, 7 – 9 and 15, which depend from claims 1 and 10, are patentable over Ignatius et al., alone or in combination with any reference of record. The applicants respectfully request reconsideration and withdrawal of the rejection of claims 5, 7 – 9 and 15 under 35 U.S.C. §102(e) over Ignatius et al.

It is asserted that 3GPP teaches the present invention as recited in claims 16, 17 and 23 – 25. In particular, regarding claim 16 it is asserted that section 9.1.1 and FIGURE 9.1 of 3GPP shows step (a) of initiating a MT-LR for a particular MS unit; section 8.3.1.1 shows step (b) of idling the MM layer of the MS unit; section 9.2.1.1 and FIGURE 9.7 shows step (c) of initiating

a MO request for services from the MS unit; section 9.2.1.1 also discloses step (d) of processing the MO request; and that FIGURE 9.7 shows step (e) of providing a response to the MT-LR. Applicants note that Figure 9.7 is titled “General Network Positioning for CS-MO-LR,” i.e., for a Mobile Originating Location Request, not for a mobile terminating location request (MT-LR) as step (a) of claim 16 recites.

While these recited steps may be, for arguments sake, independently disclosed by the 3GPP specification, even if the individual steps are each taught by the 3GPP specification, it is insufficient to find anticipation. The MPEP at §2131 provides in pertinent part:

“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements **must be arranged as required** by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

(emphasis added.) In a nutshell, the 3GPP specification does not teach MO transactions allowed to originate and complete even in the presence of an ongoing MT-LR. Thus, communications according to 3GPP specification fail to perform “the identical function specified in the claim in substantially the same way,” and do not produce “substantially the same results as the corresponding element disclosed in the specification.” MPEP at §2184. Therefore, the 3GPP specification fails to teach the present invention as recited in claim 16. The applicants respectfully request reconsideration and withdrawal of the rejection of claim 16 under 35 U.S.C. §102(b) over 3GPP.

Furthermore, because dependent claims include any differences with the prior art as the claims from which they depend, dependent claims 17 and 23 – 25, which depend from claim 16, are patentable over 3GPP, alone or further in combination with any reference of record. The applicants respectfully request reconsideration and withdrawal of the rejection of claims 17 and 23 – 25 under 35 U.S.C. §102(b) over 3GPP.

Regarding the rejection of Claim 11 under 35 U.S.C. §103(a) over the combination of Ignatius et al. and 3GPP, in addition to the fact that claim 11 depends from claim 10 and so is also patentable for the reasons that claim 10 is patentable, Ignatius et al. and 3GPP add nothing

to each other to overcome the shortfall of each. So, the combination of both references still does not result in the present invention as recited in claim 11. The applicants respectfully request reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. §103(a) over Ignatius et al. in combination with 3GPP.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the implied objection to claims 3 – 4, 6, 12 – 14, and 18 – 21, reconsider and withdraw the rejection of claims 1 – 17, 19 – 21 and 23 – 26 under 35 U.S.C. §§102(b), (c), 103(a) and 112 and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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